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| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/817,192-Conf. #2164 | |
| | Filing Date | April 2, 2004 | |
| | First Named Inventor | Swamy Mandavilli | |
| | Art Unit | 2673 | |
| | Examiner Name | P. K. Nguyen | |
| Total Number of Pages in This Submission | 7 | Attorney Docket Number | 10003778-3 |

ENCLOSURES (Check all that apply)

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| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Pre-Appeal Brief (6 pages) Return Receipt Postcard (2) |
| Remarks | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|-----------------------------|----------|--------|
| Firm Name | FULBRIGHT & JAWORSKI L.L.P. | | |
| Signature | | | |
| Printed name | Michael A. Papalas | | |
| Date | May 15, 2006 | Reg. No. | 40,381 |

Transmittal

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568259786US, on the date shown below in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

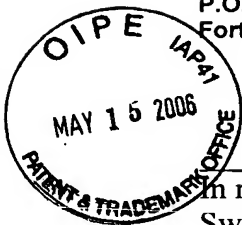
Dated: May 15, 2006

Signature: (Phyllis Ewing)

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P.O. Box 272400
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PATENT APPLICATION

ATTORNEY DOCKET NO. 10003778-3



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Swamy Mandavilli et al.

Application No.: 10/817,192

Confirmation No.: 2164

Filed: April 2, 2004

Art Unit: 2673

For: METHOD AND SYSTEM FOR
MAINTAINING PERSISTENCE OF
GRAPHICAL MARKUPS IN A
COLLABORATIVE GRAPHICAL VIEWING
SYSTEM

Examiner: P. K. Nguyen

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

In response to the Office Action dated March 13, 2006, finally rejecting claims 1-2, 5-31, please acknowledge the notice of appeal filed concurrently with this document and please consider this request for review:

Remarks/Arguments begin on page 2 of this paper.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-2, and 5-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalal et al. (6,363,404, hereinafter Dalal) in view of Powers et al. (6,362,817, hereinafter Powers).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Applicant maintains that not all of these criteria have been met.

Independent claims 1, 7, and 13 each require graphical markup items. Dalal in view of Powers does not teach this limitation. Dalal teaches markup documents that are stored as texture image files of predefined three-dimensional models (Dalal column 1, lines 63-65). Additionally, Dalal teaches that in accordance with yet other aspects of Dalal's invention, the markup documents are HTML (Hypertext Markup Language) documents. Powers is not relied upon as teaching this limitation. Applicant can find no aspect of Dalal in view of Powers that corresponds to graphical markup items. Thus, Dalal in view of Powers does not teach nor suggest graphical markup items. Therefore, Applicant respectfully asserts, for at least the above reasons, that claims 1, 7, and 13 are patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Claim 1 further requires storing the created graphical markup items and associated camera position in persistent storage. Dalal in view of Powers does not disclose at least these limitations. Dalal teaches storing a markup document as a texture file (Dalal, at least column 1, lines 63-65 and column 10 lines 4-9), yet does not teach storing an associated camera position. Powers is not relied upon as teaching these limitations. Applicant can find no aspect of Dalal in view of Powers that corresponds to storing the created graphical markup items and associated camera position in persistent storage. Thus, Dalal in view of Powers

does not teach nor suggest storing the graphical markup items and associated camera position in persistent storage. Therefore, Applicant respectfully asserts, for at least the above reasons, that claim 1 is patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Independent claims 7 and 13 require graphical markup items created by a user. Dalal in view of Powers does not disclose at least these limitations. Dalal teaches that the markup documents received by the host system from the network are requested by the host system's user or automatically sent by a remote server coupled to the host system via the network (Dalal, column 5, lines 39-42), as such the user does not create graphical markup items. Powers is not relied upon as teaching these limitations. Applicant can find no aspect of Dalal in view of Powers that corresponds to graphical markup items created by a user. Thus, Dalal in view of Powers does not teach nor suggest graphical markup items created by a user. Therefore, Applicant respectfully asserts, for at least the above reasons, that claims 7 and 13 are patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Claims 7 and 13 further require associating graphical markup items created by a user to a camera position. Dalal in view of Powers does not disclose at least these limitations. Dalal teaches the three-dimensional model's viewpoint are determined according to the received content and format information (i.e., the markup document), and that the determined viewpoint is initially a default viewpoint, and if the three-dimensional model can be manipulated, the user can change the viewpoint (Dalal, column 8, lines 26-32). However, at no point does Dalal teach or suggest associating graphical markup items to a camera position. Powers is not relied upon as teaching these limitations. Applicant can find no aspect of Dalal in view of Powers that corresponds to associating graphical markup items created by a user to a camera position. Thus, Dalal in view of Powers does not teach nor suggest storing graphical markup items and an associated camera position in persistent storage. Therefore, Applicant respectfully asserts, for at least the above reasons, that claims 7 and 13 are patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Claims 7 and 13 further require storing positioning information describing the camera position and the associated graphical markup items in persistent storage. Dalal in view of Powers does not disclose at least these limitations. Dalal teaches storing a markup document

as a texture file (Dalal, at least column 1, lines 63-65 and column 10 lines 4-9), yet does not teach storing positioning information describing the camera position and the associated graphical markup items in persistent storage. Powers is not relied upon as teaching these limitations. Applicant can find no aspect of Dalal in view of Powers that corresponds to storing positioning information describing the camera position and the associated graphical markup items in persistent storage. Thus, Dalal in view of Powers does not teach nor suggest storing positioning information describing the camera position and the associated graphical markup items in persistent storage. Therefore, Applicant respectfully asserts, for at least the above reasons, that claims 7 and 13 are patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Independent claims 19 and 25 each require an annotation of a three dimensional model. Dalal in view of Powers does not teach this limitation. Dalal teaches markup documents that are stored as texture image files of predefined three-dimensional models (Dalal column 1, lines 63-65). Additionally, Dalal teaches that in accordance with yet other aspects of Dalal's invention, the markup documents are HTML (Hypertext Markup Language) documents. Powers is not relied upon as teaching this limitation. Applicant can find no aspect of Dalal in view of Powers that corresponds to an annotation of a three dimensional model. Thus, Dalal in view of Powers does not teach nor suggest an annotation of a three dimensional model. Therefore, Applicant respectfully asserts, for at least the above reasons, that claims 19 and 25 are patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Independent claims 19 and 25 each further require creating a user defined annotation of a three dimensional model. Dalal in view of Powers does not disclose at least these limitations. Dalal teaches that the markup documents received by the host system from the network are requested by the host system's user or automatically sent by a remote server coupled to the host system via the network (Dalal, column 5, lines 39-42), as such the user does not define an annotation of a three dimensional model. Powers is not relied upon as teaching these limitations. Applicant can find no aspect of Dalal in view of Powers that corresponds to creating a user defined annotation of a three dimensional model. Thus, Dalal in view of Powers does not teach nor suggest creating a user defined annotation of a three dimensional model. Therefore, Applicant respectfully asserts, for at least the above reasons,

that claims 19 and 25 are patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Independent claim 25 requires displaying the annotation only when the requested camera position matches the predefined camera position. Dalal in view of Powers does not disclose at least these limitations. Dalal teaches that as the viewpoint changes or the three-dimensional model is moved, the markup documents displayed as textures on the three-dimensional models move in real-time with the models (Dalal, column 7, lines 49-53), as such the annotations are not only displayed when the requested camera position matches the predefined camera position. Applicant can find no aspect of Dalal in view of Powers that corresponds to creating displaying the annotation only when the requested camera position matches the predefined camera position. Thus, Dalal in view of Powers does not teach nor suggest displaying the annotation only when the requested camera position matches the predefined camera position. Therefore, Applicant respectfully asserts, for at least the above reasons, that claim 25 is patentable over Dalal in view of Powers and requests the 103(a) rejection be withdrawn.

Dependent claims 2, 5-6, 8-12, 14-18, 20-24, and 26-31 each depend from one of independent claims 1, 7, 13, 19, and 25, thus inheriting all the limitations of their respective base claim. Each of claims 1, 7, 13, 19, and 25 set forth features and limitations not found in the cited prior art. Thus, claims 2, 5-6, 8-12, 14-18, 20-24, and 26-31 each contain features and limitations not found in the cited prior art, as discussed above. Therefore, Applicant respectfully asserts that claims 2, 5-6, 8-12, 14-18, 20-24, and 26-31 are patentable over Dalal in view of Powers and requests the 103(a) rejection be removed.

Applicant further notes that any grouping of claims in this Pre-Appeal Brief does not limit the grouping of claims for any subsequent documents or responses related to the prosecution of the instant application. As such, any Appeal Brief may contain a different grouping of claims than that of any found within this document.

Application No. 10/817,192
Amendment dated: 05/15/2006
After Final Office Action of March 13, 2006

Docket No.: 10003778-3

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10003778-3 from which the undersigned is authorized to draw.

Dated: 05/15/2006

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV568259786US, on the date shown below in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: 05/15/2006

Signature: 

(Phyllis Ewing)

Respectfully submitted,

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